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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,085	09/15/2003	Virginia McNaughton		1678
7590	02/12/2004		EXAMINER	
GEOFFREY NEEDHAM PLANTHAVEN INC P.O. BOX 3056 SANTA BARBARA, CA 93130-3056			HWU, JUNE	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/663,085	MCNAUGHTON, VIRGINIA	
	<b>Examiner</b>	<b>Art Unit</b>	
	June Hwu	1661	

**— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 15 September 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input checked="" type="checkbox"/> Other: <u>MPGP 324</u>               |

Art Unit: 1661

### **DETAILED ACTION**

Plant Haven, Inc. does not have the right to take action for this instant application.

Although the applicant states on the statement under CFR 3.73(b) that assignment papers have been sent, none have been received. The assignee must establish the right to prosecute this application by documentary evidence of a chain of title from original owner to the assignee (copy of an executed assignment) or by specifying (reel and frame number) where such evidence is recorded in the Office. See MPEP 324 and 37 CFR 3.73 (attached with this Office Action).

### **Drawings**

An Official Draftsman has approved the drawings.

### **Objection to the Disclosure**

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

#### **35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

- A. Page 1, line 4, Applicant should italicize or underline the genus name of the observed plant, as this is the convention employed by the International Code of Nomenclature.
  
- B. Page 1, line 6, the recitation "Species: *xhybrida*" does not appear accurate. Applicant describes the parentage of the claim plant as *Santolina pinnata* subsp. *Neapolitana* (seed

Art Unit: 1661

parent) and *S. chamaecyparissus* 'Lemon Queen' (pollen parent). The species name should be "*pinnata x chamaecyparissus*", if accurate. Correction is necessary.

C. Applicant should set forth in the specification the cultivar name of the seed parent or if unknown, such should be disclosed in the specification.

D. Applicant is requested to recite whether the seed parent has been patented in the United States, is currently the subjects of pending U.S. plant patent applications, or are unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the appropriate cultivar name. If the cultivar is subject of a pending application, such should be referred to by serial number. If non-patented, --(unpatented)-- should be inserted after the appropriate cultivar name.

E. Sheet 3 shows a photograph of a plant named *Santolina* 'Shades of Jade'. It is unclear if this drawing is of the claimed plant or of another plant. If 'Shades of Jade' is a trade name, such should be disclosed in the specification. Clarification and/or correction are necessary.

F. Applicant should set forth in the specification the number of ray florets and disc florets per inflorescence.

G. Page 7, line 17, the recitation "100+" is vague and does not adequately describe the number of involucral bracts per inflorescence. It is suggested that Applicant describes the number of involucral bracts within a range or an average amount.

Art Unit: 1661

H. Page 7, line 30, the recitation "10 stamens in number" is unclear. It is uncertain if this quantity refers to the disc florets, ray florets, or total number per inflorescence. Applicant should import in the specification the number of stamens per disc floret and ray floret, if any.

I. Applicant should set forth in the specification the number of pistils per disc floret and ray floret, if any.

J. If available, Applicant should set forth in the specification a botanical description of the fruit, such as size, color designation and surface texture.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

### **Claim Rejection**

#### **35 USC § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

**Amendments in a Revised Format is Now Mandatory**

Compliance to the revision to 37 CFR 1.121 is mandatory. Complete details to the revised amendment format can be found on the Internet at  
<http://www.uspto.gov/web/offices/com/sol/og/2003/week08/patform.htm>.

### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

JH



ANNE MARIE GRUNBERG  
PATENT EXAMINER